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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/663,779 | 09/15/2000 | David R. Corbin | 35-21(51376)B | 2711 |

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EXAMINER

KUBELIK, ANNE R

ART UNIT PAPER NUMBER

1638

DATE MAILED: 12/14/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|-----------------------------|------------------|---------------|
| Offic Action Summary | Applicati n N . | Applicant(s) |
| | 09/663,779 | CORBIN ET AL. |
| | Examiner | Art Unit |
| | Annie R. Kubelik | 1638 |

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-50 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) Other: *detailed action* .

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, 25-35, 38-39 and 49, drawn to a nucleic acid, cells and plants transformed with that nucleic acid and a method of generating a transgenic plant, classified in class 800, subclass 278, for example.
- II. Claims 17-24 and 50, drawn to a protein, classified in class 530, subclass 350, for example.
- III. Claims 36-37, drawn to computer readable medium, classified in class 360, subclass 131, for example.
- IV. Claim 40, drawn to a method for identifying a gene for an insect inhibitory protein, classified in class 435, subclass 91.1, for example.
- V. Claims 41-48, drawn to a method for identifying plasmid DNA of a *Bacillus* species, classified in class 435, subclass 6, for example.

The inventions are distinct, each from the other because:

Inventions I and IV-V are unrelated to invention II. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions have different modes of operation and different functions. The first set of inventions is distinct from invention II because the former require isolated DNA not required by the latter, while the latter requires isolated proteins not required by the former. Furthermore, the protein of invention II could be made by a process other than the expression of the gene of invention I, such as chemical synthesis or purification from the natural source, and

the DNA of invention I may be used for processes other than the production of protein, such as a nucleic acid hybridization assay. Lastly, DNA and protein differ in composition, structure and function.

Inventions I and IV-V are unrelated to each other. Invention I requires methods for plant transformation and regeneration, not required by the other inventions. Invention IV requires methods for identifying insect inhibitory proteins, not required by the other inventions. Invention V requires DNA libraries from two different *Bacillus* strains, not required by the other inventions.

Inventions I-II and IV-V are unrelated to invention III. Inventions I-II and IV-V require nucleic acids or proteins, not required by invention III, which requires a computer readable medium and methods for recording information on it, not required by the other inventions.

Applicant is reminded that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434).

Upon election of either Group I or II, Applicant is additionally required to select a single nucleotide sequence for said Group. This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of single genus of invention, but constitutes an independent and patentably distinct invention. Upon

election of a single nucleotide sequence, claims that are not drawn to the function of the protein encoded by that nucleotide sequence will be withdrawn from consideration.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search, and classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula K. Hutzell, can be reached on (703) 308-4310. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 or (703) 872-9306 for regular communications and (703) 308-4242 or (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst, Dianeice Jacobs, at (703) 305-3388.

Anne R. Kubelik, Ph.D.
December 5, 2001

DAVID T. FOX
PRIMARY EXAMINER
GROUP 1638

